IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Docket No. 25814-406470)

In re the Application of:)
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ANTHONY BAERLOCHER)
) Art Unit: 3713
Serial No.: 09/964,060)
)
Filed: September 26, 2001) Examiner Enatsky
)
For: GAMING APPARATUS AND METHOD)

TO: Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO FINAL REJECTION

Dear Sir:

In response to the Office Action and Final Rejection of September 26, 2003,

reconsideration of this application and allowance of the claims is requested.

The examiner has rejected claims 1-6 and 18 as unpatentable over Schneider et

al. U.S. Patent No. 6,089,976, in view of Walker U.S. Patent No. 6,174,235.

Even if such a combination is made, there is a clear missing element, not found

in the combination, and found in claim 1 and its dependent claims.

Specifically, claim 1 (amended) calls for (beginning at line 11):

"...the stored program control operable to select first and second pay
values from a plurality of possible pay values, and randomly associate the
selected first pay value with at least one of the second indicia from a first
matching group of second indicia and randomly associate the selected
second pay value with at least one of the second indicia from a second
matching group of second indicia . . ."

Support in the specification for this is found for example at Fig. 5, step 41 of the

process shown, as well as at Fig. 8, step 41. As stated therein, a pay value is randomly

associated with at least one of the second indicia from a first matching group and at least one of the second indicia from a second matching group. Specifically referring to Fig. 4 of this application, one matching group specifically shown is matching pair 35 of the character "E", as described at page 6, last full paragraph of the specification. Thus, in the apparatus of claim 1, a program control is present that assigns a randomly associated pay value to the second indicia, such as each E 31. This is paid to a player who successfully selects a pair of E's from the array 31, as shown in Fig. 4. It would also be possible in this game to correctly select two or three O's, and this would result in a different, randomly provided pay value. Thus, the player, in successive games, is obtaining different potential awards for making the same selection (two E's, for example). This, of course, adds to the variety, excitement and interest of the game.

Furthermore, as called for in the last two lines of claim 1, the stored program control is "...operable for displaying the pay value on the display in an area separate from the first and second indicia." See paytable 39 of Fig. 6 to support this, along with the disclosure in the last paragraph of page 8.

To be sure, other variables are present. Particularly, the various second indicia can be moved around under the masking first indicia before playing of each game, so desired second indicia will be in new positions and hard to find. However, that is a different kind of variability, which is admittedly known to the art. The variability specifically called for in claim 1 and discussed above, however, is new.

In support of this, the attention of the examiner is directed to Walker et al. Note the indicia of Fig. 5. To be sure, between the various games, the indicia will be moved around in its matrix of locations 120 in a manner described in the specification of Walker

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et al. However, contrary to this invention, the indicia <u>do not vary their rewards</u>. The reward for indicium 132 is, obviously, $50.00 every time. Similarly, indicium 128 gives $5.00 every time it is selected, and the same goes for indicia 126.

The examiner is urged to note that this is entirely contrary to the requirement of claim 1 of this application, in which the stored program control is operable to "...<u>randomly</u> associate the selected first pay value with at least one of the second indicia from a first matching group of second indicia and randomly associate the selected second pay value with at least one of the second indicia from a second matching group of second indicia...". That clearly happens in the disclosure of this present invention, as illustrated by Figs. 5 and 8, as previously discussed. It simply does not happen in Fig. 5 of Walker et al., where a $50.00 reward, remains a $50.00 reward no matter where it is located on the matrix.

Turning to Fig. 6 of Walker et al., another matrix is shown, similar in spirit to a punch board, as described at the top of column 7, lines 7- *et seq.* During each game, the player selects three locations from the plurality of locations 140, thereby defining a subset of three elements that defines the outcome and payout for that game. Of course, each of the plurality of locations 140 is hidden or obscured until selected by the player.

There is no teaching in Walker et al. about any variability of reward that is provided when a player successfully picks, for example, three bars. The paytable is submitted to be a standard, external paytable of fixed values.

It is submitted that the other embodiments of Walker et al. also represent only winning combinations having fixed rewards. In Fig. 7, the respective, fixed rewards are

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listed, ranging from $50.00 to $1.00. In Fig. 10, the rewards are not provided, because those skilled in the art would understand that a fixed, external paytable would be used to determine rewards for winning combinations.

Thus, it is submitted that Walker et al. teaches nothing of the cited portions of claim 1 of this application.

When Walker et al. and Schneider et al. are combined, the resulting combination fails to teach the specific limitations discussed above of claim 1 and its dependent claims. The values of the winning selections or combinations are fixed, not randomly varied as in this invention. Thus, contrary to the examiner's statement at the end of paragraph 1 on page 3 of the latest Office Action, one would not be motivated to modify Schneider to use random indicia and value association...if by that it is meant that the values of the respective winning picks and combinations are randomly varied from game to game, as called for in claim 1 and its dependent claims.

The examiner has also rejected claims 7-8, 13, 15 and 22-23 as unpatentable over Schneider in view of Walker as applied above, further in view of Vancura U.S. Patent No. 6,033,037.

Claims 7 and 8 share in the distinctions of parent claim 1. Vancura does not add to the combination rejection the teaching which is missing from the combination, as discussed above.

Turning to claim 13, the attention of the examiner is directed to the language beginning on line 5 of claim 13 (amended):

> "...selecting a first pay value, to form a plurality of possible pay values, wherein the first selected pay value is randomly associated with a first group of matching indicia..." (emphasis added).

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As previously discussed, randomly associating a pay value with a first group of matching indicia (so that a variability of the pay value takes place in sequential games) is a new step and a new way of providing variety and interest to a game, not taught in any of the three references cited in the rejection under discussion.

Similarly, in claim 13 (amended) at line 13, note the language

> "...selecting a second pay value from the plurality of possible values;
>
> randomly associating the second selected pay value with at least one of the indicia from a second group of matching indicia.
>
> displaying the pay values on the display in an area separate from the indicia..."

It is submitted that this claim language also is not taught in the combination of three references raised by the examiner in the rejection under discussion. In this portion of claim 13, as well as the previous portion, the random association of a pay value with at least one of the indicia is submitted to be new, and not taught in the combination of references.

This new step provides an added dimension through which interest in the game cam be maintained and stimulated.

Accordingly, it is submitted that claim 13, and its dependent claims, are patentable, irrespective of what Vancura teaches about multipliers.

Referring to the remaining rejections, they all relate to claims which are dependent upon the two independent claims discussed above. Thus, they share in the patentable distinctions which have been discussed herein, and are thus believed to be patentable over the various rejections raised.

Respectfully submitted,
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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 2313-1450, on October __7__, 2003.

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Registered Attorney for Applicant
Date: October __7__, 2003

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